

## REMARKS/ARGUMENTS

Claims 5 and 12 have been amended.

### **Statement of Common Ownership**

The present application, U.S. Patent Application 09/587,092, and PGPUB US 2002/0175207 to Kashef et al. were, at the time of the invention of the present application, U.S. Patent Application 09/587,092, was made, owned by Visa International Service Association.

The Examiner rejected claims 1, 4-7, and 9-15 under 35 U.S.C. § 103(a) as being unpatentable over Heinonen et al. (U.S. 5,887,266), hereinafter Heinonen in view of Baker et al. (U.S. 5,884,292), hereinafter Baker.

**Regarding claim 1**, the Examiner stated that “Heinonen does not explicitly disclose arranged to be inserted in said handset, and an input interface for indicating a value to be loaded onto said smart card, said handset being arranged to generate a request message to load the value onto the smart card.” The Examiner further stated “Baker discloses arranged to be inserted in said handset, and an input interface for indicating a value to be loaded onto said smart card, said handset being arranged to generate a request message to load the value onto the smart card [abs; Fig. 1; C1 L5-L37; C2 L62-67; C3 L22-L45; C4 L15-20].” Baker does not disclose inserting a smart card into a handset, as recited in claim 1. Claim 1 recites that the handset is a mobile telephone handset. Baker does not teach that the smart card is arranged to be inserted into the mobile telephone handset. Baker in Fig. 1 and col. 3, lines 33-65, teaches the use of a smart card reader 38, which is wired to a microcomputer 32, which is wired to a touch screen 40, a postage meter 34, a scale 42, and a modem 44 in a station 30. This station is not a mobile telephone handset. The Examiner failed to point out anything in Baker that discusses placing a smart card into a mobile telephone hand set. In addition, it would not be obvious to combine Heinonen with Baker to obtain the smart card loading system, as recited in claim 1.

In addition, Heinonen teaches away from using a mobile telephone handset for communicating with a smart card separate from the subscriber identification module (SIM) of the handset. The Examiner cited col. 1, line 57, to col. 2, line 14, of Heinonen as teaching that the handset communicates with a smart card separate from the SIM. The passage cited by the Examiner is the description of the prior art, which Heinonen says has disadvantages. When Heinonen goes on to describe the invention, the Examiner failed to cite anything in Heinonen that states that the invention has a smart card separate from the SIM. Baker does not teach a

separate smart card and SIM. For at least these reasons, claim 1 is not made obvious by Heinonen in view of Baker.

**Regarding claim 9**, the Examiner cites col. 10, lines 18-27 of Heinonen for teaching placing the smart card in contact with the point-of-sale terminal. Claim 9 recites removing the smart card from the handset and placing the removed smart card in contact with a point-of-sale terminal to provide a contact interface with said point-of-sale terminal, and using the point-of-sale terminal to debit said smart card to perform a purchase. Heinonen teaches away from this limitation. Instead of placing the smart card loaded by a mobile handset in physical contact with a point-of-sale terminal, Heinonen teaches using the telecommunications network or IR or some other remote communication. The passage cited by the Examiner teaches that such contact is made by an IR data transfer. Such a transfer is made when the card is in the handset. In addition, Heinonen teaches SIM cards that are not used as credit cards, which would have a contact interface with a point-of-sale terminal. Col. 3, lines 25-36, of Heinonen discusses how a mobile station may be used “instead of traditional plastic cards.” Heinonen does not use traditional plastic credit cards, which would come into contact with a point-of-sale terminal, but instead uses wireless calling or IR communications for point-of-sale purchases. Since Heinonen does not use traditional plastic cards, it would not be obvious to combine Heinonen with the card loading system of Baker make obvious the invention of claim 9, which recites placing the removed card in contact with a point-of-sale terminal to provide a contact interface. In addition, the Examiner failed to point to anything in Heinonen or Baker that would suggest combining the teachings of Baker with Heinonen to provide contact of the smart card on Heinonen with a point of sale terminal or to validate a second cryptographic signature. For at least these reasons, claim 9 is not made obvious by Heinonen in view of Baker.

**Regarding claim 12**, the Examiner cites col. 1, lines 10-25, and col. 2, lines 50-55, of Heinonen for teaching receiving a request from a user to load a value into a stored-value application of the smart card inserted in the handset. The cited passage does not teach receiving a request for loading a value onto a smart card that is not the subscriber identification module (SIM) of the handset. The Examiner did not cite anything in Heinonen that teaches loading a value onto a smart card from a handset with a SIM, which is different from the smart card. In addition, claim 12 has been amended to recite that an authorization response certificate is received by the smart card through the handset. For at least these reasons and the reasons discussed above regarding claim 1, claim 12 is not made obvious by Heinonen in view of Baker.

**Claims 4-7, 10-11, and 13-15** are directly or indirectly dependent on the independent claims, and are therefore respectfully submitted to be patentable over the art of record for at least the reasons set forth above with respect to the independent claims. Additionally, these dependent claims require additional elements that when taken in the context of the claimed invention, further patentably distinguish the art of record. For example, claim 15 recites generating a transaction certificate to be used for irrepudiation. The Examiner did not point out anything in Heinonen or Baker that discloses or makes obvious this feature. For at least these reasons, claims 4-7, 10-11, and 13-15 are not made obvious by the cited references.

The Examiner rejected claims 2-3, 8, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Heinonen et al. (U.S. 5,887,266), hereinafter Heinonen in view of Baker et al. (U.S. 5,884,292), hereinafter Baker, as applied to claims 1, 5, and 12 above, and further in view of Kashef et al. (PGPUB US 2002/0175207) hereinafter Kashef.

As stated above, Kashef is commonly owned with the present application, and according to MPEP 706.02(l)(1) and 35 U.S.C. 103(c) may not be used as a reference for a rejection under 35 U.S.C. 35 U.S.C. 102(e)/103.

In addition, **claims 2, 3, 8, and 15** are directly or indirectly dependent on the independent claims, and are therefore respectfully submitted to be patentable over the art of record for at least the reasons set forth above with respect to the independent claims. Additionally, these dependent claims require additional elements that when taken in the context of the claimed invention, further patentably distinguish the art of record. For example, claims 8 and 15 recite generating a transaction certificate to be used for irrepudiation. It would not be obvious to combine the teachings of Kashef with Heinonen and Baker to obtain the invention as claimed in claims 8 and 15. In addition, regarding claim 2, the Examiner states that Heinonen does not explicitly disclose a smart card loading system. It would not be obvious to combine Heinonen with Kashef to obtain a smart card loading system on a mobile telephone handset. For at least these reasons, claims 2, 3, 8, and 15 are not made obvious by the cited references.

Applicants believe that all pending claims, as amended, are allowable and respectfully request a Notice of Allowance for this application from the Examiner. Should the Examiner

believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at telephone number (831) 655-2300.

Respectfully submitted,  
BEYER WEAVER & THOMAS, LLP

A handwritten signature in black ink, appearing to read "Michael Lee", with a stylized flourish at the end.

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